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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,274	01/22/2004	Tsuyoshi Kaneko	118117	3171
25944	7590	12/14/2005		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				
			EXAMINER PETKOVSEK, DANIEL J	
			ART UNIT 2874	PAPER NUMBER

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

<b>Office Action Summary</b>	<b>Application No.</b> 10/761,274	<b>Applicant(s)</b> KANEKO ET AL.	
	<b>Examiner</b> Daniel J. Petkovsek	<b>Art Unit</b> 2874	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on election filed November 18, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/22/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is in response to the election filed November 18, 2005. In accordance with the election, Group II (namely claims 22-27) are pending examination.

#### ***Election/Restrictions***

1. Applicant's election with traverse of the restriction mailed October 19, 2005 in the reply filed on November 18, 2005 is acknowledged. The traversal is on the grounds that there is no sufficient burden placed upon the examiner and the searches would generally overlap. This is not found persuasive because the searches for the method (elected) and apparatus are different, and place a sufficient burden upon the examiner to require a restriction.

The requirement is still deemed proper and is therefore made **FINAL**.

2. Claims 1-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected group, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 18, 2005.

#### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### ***Information Disclosure Statement***

4. The prior art documents submitted by Applicant in the Information Disclosure Statements filed on January 22, 2004, have been considered and made of record (note attached copy of forms PTO-1449).

#### ***Claim Objections***

5. Claim 22 is objected to because of the following informalities: in section (b), “by discharging droplet”, should read “by discharging *a* droplet”. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 22-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Cox et al. US 2001/0048968 A1.

Cox et al. US 2001/0048968 A1 teaches (Figs. 5-9; [0030]-[0032]) a method of manufacturing an optical element that receives light, comprising: forming a base member 22 over a light-receiving surface 14, forming an optical element precursor by discharging droplet(s) to the top of the surface of the base member 22, forming an optical element (gradient index lens, etc) by curing/heating the optical element precursor, which clearly, fully meets Applicant's claimed limitations.

Regarding claim 23, the base member 14 inherently passes a “predetermined” wavelength, relative to its optical characteristics.

Regarding claims 24 and 25, in another embodiment, layer 30 can be viewed as the base material, with layer 24 as the optical element, and as such, the shapes and angles of the base are angled acutely and/or in a tapered fashion, based upon curvatures.

Regarding claim 26, different wettabilities are disclosed (see [0038]).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cox et al. US 2001/0048968 A1.

Cox et al. US 2001/0048968 A1 teaches (Figs. 5-9; [0030]-[0032]) a method of manufacturing an optical element that receives light, comprising: forming a base member 22 over a light-receiving surface 14, forming an optical element precursor by discharging droplet(s) to the top of the surface of the base member 22, forming an optical element (gradient index lens, etc) by curing/heating the optical element precursor. Cox et al. '968 does not explicitly teach that the optical element can be sealed or protected from the environment. A person having ordinary skill in the art at the time the invention was made would have recognized sealing/covering/protecting an optical element for the purpose of eliminating errors and outside influences that would decrease optical coupling performance. Official notice has been taken to this claim limitation.

#### ***Inventorship***

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 2874

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

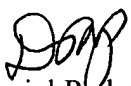
*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, with respect to the state of the art of optical elements for by curing droplets: PTO-892 form references B-G and N.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Petkovsek whose telephone number is (571) 272-2355. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney Bovernick can be reached on (571) 272-2344. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Daniel Petkovsek  
December 3, 2005

  
AKIM ENAYET ULLAH  
PRIMARY EXAMINER